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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,310	09/24/2001	Farhad Barzegar	03493.00299	6519

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EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 11/05/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,310

Applicant(s)

BARZEGAR ET AL.

Examiner

Phuongchau Ba Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-24-01; 12-27-01 Pre-Amendts.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4, 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 24 September 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5. 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "said phone is operable without power being supplied FROM said phone"{claim 3, line 4; claim 8, line 8; claim 9, line 8} must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

3. The disclosure is objected to because of the following informalities: page 27 of the preliminary amendment which filed in 9-24-01, the attorney docket in each number of 38-41 should be deleted and replaced with a corresponding U.S. Application Serial Numbers.

Appropriate correction is required.

Claim Objections

4. Claims 7-9 are objected to because of the following informalities:
Claim 7, line 2: "a switch" should be changed to ---said switch---
Claims 8-9, line 9:--said--- should be inserted before "conductor", and
---at--- should be inserted before "remote end";
Claim 9, line 10: --said--- should be inserted before "telephone";
Appropriate correction is required.

Claim Rejections – 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 3-4, 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original disclosure does not support "said phone is operable without power being supplied FROM said phone"{claim 3, line 4; claim 8, line 8; claim 9, line 8}.

Claims 4 and 7 are rejected in virtue of their dependencies to claim 3.

Claim Rejections – 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-4, 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Regarding to method claimed, claims 3, 8-9 are vague and indefinite because claims 3 & 8-9 are not clear what is meant by "said phone is operable without power being supplied FROM said phone"{claim 3, line 4; claim 8, line 8; claim 9, line 8}. Claim 4 and 7 are rejected in virtue of their dependencies to claim 3.

Claim 3 recites the limitation "said remote end" in line 13. Claims 8-9 recite the limitation "said conductor" in line 10 and "said to" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Also, claim 3 is vague and indefinite because claim 3 is not clear what is meant by "said remote end of said wire being one of connected to said port one of directly and selectably through a switch"{claim 3, lines 13-14}

Claims 8-9 are vague and indefinite because claim 8 is not clear what is meant by "a switch for connecting conductor remote end to said port"{claim 8, line 9; claim 9, line 9}, "a POT/telephone connectable by said server to said conductor at a conductor local end"{claim 8, lines 10; claim 9, line 10}, "remote and local modems linked at said conductor remote and local ends"{claim 8, lines 11-12}.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 3-4, 10-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-4 of U.S. Patent No. 6,347,075. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim 3 merely broadens the patented claims 3-4 by eliminating "said switch is controlled by a controller and said controller closes said switch responsively to a failure to receive at said local modem a message from said remote modem or

a failure to receive at said remote modem a message from said local modem” from claim 4 and “said switch is controlled by a controller and said controller closes said switch responsively to an occurrence of a failure of one of said remote and said local modems” from claim 3. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd.App.1969) ; omission of a reference’s element whose function is not needed would be obvious to an artisan.

Also, application claims 10-11 merely broaden patented claims 3-4 by rephrased the claimed limitations. Therefore, it would have been obvious to an artisan to rephrase the claimed limitation to clarify the claimed language to avoid confusion.

Claim Rejections – 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim(s) 3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell (5,930,340) in view of Seazholtz (5,812,786).

Bell discloses in figure 1 (safety device) a computer, which comprises a not shown xDSL modem (remote modem){column 5, lines 15-17}, being connected to xDSL modems 111 (local modem) at a central office 101 (subscriber server). The central office 101 comprises a telephone voice network (first network interface) and WAN services (second network interface) via a subscriber line 105. Bell further discloses a telephone 123 and 125 being connected directly to the xDSL modems 111 via a splitter 107 and 127 (line card).

Bell does not explicitly disclose that said phone is operable without power supplied and said remote end of said wire pair connected to said port one of directly and selectively through a switch (claim 3).

Seazholtz discloses a POTS switch 19 and ADSL/AVR interface 48 (xDSL modem) in a central office 10 {column 7, lines 29–32}. Therefore, it would have been obvious to a skilled artisan to implement the POTS switch 19 and ADSL/AVR interface 48 in the central office 10 of Seazholtz's system to the central office 101 of Bell's system with the motivation to provide the telephone service working if the power goes out as explicitly suggested by Seazholtz in column 7, lines 29–32.

It is inherent that the telephone 121 and 123 in Bell's system using a first range of frequency spectrum of said subscriber link 105, and the xDSL modem (remote modem) at the computer 113 and the xDSL modems 111 (local modem) at the central office because Bell's system discloses xDSL modems (i.e., ADSL, HDSL, SDSL, VDSL) for transmitting data and voice transmission over a same transmission medium (i.e., subscriber link) using different frequency band for data transmission (i.e., POTS/narrow band which is equal to 4 kHz and below) and for voice transmission (i.e., ISDN/broad band which is above 4 kHz)(claims 8–9){see column 1, lines 40–54}. See also figure 4 in Seazholtz's system.

Regarding claim 4:

Bell does not explicitly disclose the claimed invention. However, in the same field of endeavor, Seazholtz further discloses wherein said remote end of said wire is connected to said port selectably through a switch (12-15, fig.1) controlled by a controller (11, fig.1). Therefore, it would have been obvious to an artisan to apply Seazholtz's teaching to Bell's system with the motivation being to allow video or demand as well as other high bit rate data communications over the ADSL/AVR interface units.

Regarding claim 7:

Bell further discloses wherein said remote end of said wire is connected to said port selectably through a switch that defaults to connect said remote end to said port when power to said switch is lost {col.7, line 62-col.8, line 2, wherein the internal battery is used when there is a shortage from the power supply}.

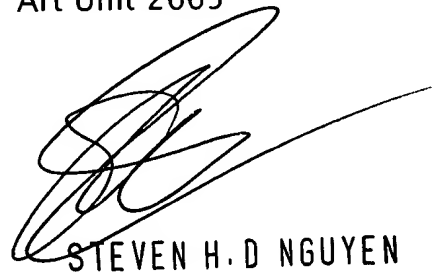
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday 10:00AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Phuongchau Ba Nguyen
Examiner
Art Unit 2665



STEVEN H.D NGUYEN
PRIMARY EXAMINER